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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,682	06/16/2005	Alexander Macasaet	30882/DP027	8592
4743	7590	04/10/2009	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP			PERREAU, ANDREW D	
233 SOUTH WACKER DRIVE				
6300 SEARS TOWER			ART UNIT	PAPER NUMBER
CHICAGO, IL 60606-6357			3728	
			MAIL DATE	DELIVERY MODE
			04/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/539,682	MACASAET ET AL.
	Examiner	Art Unit
	ANDREW PERREAU	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 December 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3, 5-13 and 15-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/31/2008</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 5, 9, 10, 13, and 17-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi et al. (JP10059364 as provided by applicant) and Boersma (2003/0052038).

Re claim 1, Hiroshi discloses a container (abstract; fig 1-6) including three sidewalls with corners therebetween (fig 6), the sidewalls defining an internal space for storage of one item and a storage area, the shape of the storage area depending on the number of the sidewalls (fig 1-6); the sidewalls being foldable about the corners for ease of storage (fig 6); the sidewalls having an open base and an open top (fig 6); a pallet with a planar and solid top onto which the sidewalls can be placed (fig 1-6); and a sidewall of the container having one perforated line to enable the height of the sidewall to be varied, wherein the one perforated line is parallel to an edge of the base for folding; but does not disclose that each side wall has a perforated line.

However, Boersma discloses a similar device (10; fig 11, 12, 13) including four sidewalls (26) with corners there between, the sidewalls defining an internal space for storage of an item; the sidewalls being foldable about the corners (72, 176; fig 13) for ease of storage (fig 11, 12); the sidewalls having a base (19) and an open top (18); a

pallet (14) with a planar and solid top onto which the sidewalls can be placed (fig. 11, 12); each sidewall of the container having a perforated line (70, 170, 172) to enable the height of the sidewalls to be varied, wherein the perforated line is parallel to an edge of the base for folding (fig 11, 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the Hiroshi reference, such each side wall has a perforated line, as suggested and taught by Boersma, for the purpose of improving the environment (paragraph 4) and for reducing volume of the container to allow the user to customize the device and its contents (paragraph 8).

Re claim 2, Boersma discloses wherein the sidewalls are made of a material selected of cardboard (page 4, claim 2).

Re claim 5, Boersma discloses that the sidewalls are foldable along the perforated line to vary the height of the sidewalls (fig 11, 12).

Re claim 9, the combined references enable an item to be placed directly on the pallet. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 13, Boersma discloses that the sidewalls and the pallet combine to form an open-top box (fig 11).

Re claim 17, Boersma discloses a cover (16; fig 1, 5) for the open top and the internal space.

Re claim 10, Boersma discloses wherein the cover is shaped to conform with the internal space defined by the sidewalls and comprises a cover top (90), and cover sides (92), the cover being adapted to be readily removable over the open top and locatable on an outer surface of the four sidewalls in the manner of a snug fit (paragraph 40). Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 18, Hiroshi discloses three sidewalls with corners (abstract; fig 1-6) therebetween for use in a container wherein the sidewalls define an internal space for storage of one item and a storage area (fig 6), the sidewalls being foldable about the corners for ease of storage (fig 6), having an open base and an open top (fig 6), and a sidewall having one perforated line to enable the height of the sidewalls to be varied, wherein the perforated line is parallel to an edge of the base and the height of each perforated line above the edge of the base is capable of being set to conform with industrial standards for transportation boxes; but does not disclose that each side wall has a perforated line.

However, Boersma discloses a similar device (10; fig 11, 12, 13) including four sidewalls (26) with corners there between, the sidewalls defining an internal space for storage of an item; the sidewalls being foldable about the corners (72, 176; fig 13) for ease of storage (fig 11, 12); the sidewalls having a base (19) and an open top (18); a pallet (14) with a planar and solid top onto which the sidewalls can be placed (fig. 11, 12); each sidewall of the container having a perforated line (70, 170, 172) to enable the

height of the sidewalls to be varied, wherein the perforated line is parallel to an edge of the base for folding (fig 11, 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the Hiroshi reference, such each side wall has a perforated line, as suggested and taught by Boersma, for the purpose of improving the environment (paragraph 4) and for reducing volume of the container

Re claim 19, the combined references disclose a single standardized container (Boersma 10; Hiroshi fig 1-6) that may be customized to meet the needs of different load and height requirements of objects to be stored and transported comprising the container. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Ex parte Masham, 2 USPQ2d 1647 (1987).

Re claim 20, the combined references disclose wherein the storage area has a rectangular shape (Hiroshi fig 1-6).

2. Claims 3, 11, and 12 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references as applied to claim 2 above, and further in view of applicant's admitted prior art (with reference to claims 3, 11, and 12 in office action 10/24/08, applicant has not challenged the examiner's official notice; therefore, the official notice is now considered admitted prior at. See MPEP 2144.03).

Re claim 3, the combined references do not disclose wherein the material is weather-resistant and the pallet material. However, applicant's admitted prior art discloses wherein the material is weather-resistant. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, including wherein the material is weather-resistant, as suggested and taught by applicant's admitted prior art, for the purpose of protecting the device from damage.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references as applied to claim 1 above, and further in view of Rose (6,119,929).

Re claim 6, the combined references do not disclose wherein the sidewalls are shearable along the perforated line to vary the height of the sidewalls. However, Rose discloses a similar container (40; fig 4) with sidewalls (26, 28) and a perforated line (32); wherein the sidewalls are shearable ("a means for permitting the tearing" col. 15, line 8-32) along the perforated line to vary the height of the sidewalls. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the sidewalls are shearable along the perforated, as suggested and taught by Rose, for the purpose of varying the height of the sidewalls to conform to different storage items.

4. Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references as applied to claim 1 above, and further in view of Lochmiller (4,383,609).

Re claim 7, the combined references do not disclose wherein the top being of a length and width slightly greater than the corresponding dimensions of the sidewalls. However, Lochmiller discloses a container (40; fig 4, 6) with sidewalls (45, 46, 47, 48; col. 2, lines 12-13; fig. 4, 6); a pallet (10; col. 1, line 36; fig. 1, 6, 7, 9) with a planar and solid top; wherein the top (fig 1) being of a length and width slightly greater than the corresponding dimensions of the sidewalls (fig 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the top being of a length and width slightly greater than the corresponding dimensions of the sidewalls, as suggested and taught by Lochmiller, for the purpose of preventing the container from falling from the pallet by creating a larger pallet than the container.

Re claim 8, Lochmiller discloses wherein a gap is formed between an outer edge of the four sidewalls and a peripheral edge of the top of the pallet (fig. 9).

Re claims 15-16, Boersma and Lochmiller disclose that the top of the pallet forms a solid base for the sidewalls (respectively, fig 11, 12; fig. 9, 10).

5. Claims 2, 3, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined references as applied to claim 1 above, and further in view of Barnes et al. (3,968,895).

As to claims 2-3 and 11-12, the combined references disclose the claimed invention but do not disclose that the sidewalls are made of a plastic weather-resistant material or that the pallet is formed of a plastic weather-resistant material. However, Barnes et al. teaches a similar container 1 (fig. 1) including four sidewalls 11a-11c, 15, a cover 37, and a pallet 3 (fig. 1) wherein the sidewalls 11a-11c, 15 are made of a material consisting of plastics (col. 5, lines 30-41), wherein the material is weather-resistant (col. 5, lines 30-41); and the pallet 3 is formed of a material of plastics (col. 5, lines 30-41), wherein the material is weather resistant (col. 5, lines 30-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the sidewalls and pallets are made of a plastic weather-resistant material, as suggested and taught by Barnes et al., in order for the container to be reused by being capable of withstanding damage from rough transporting conditions such as inclement weather and chemicals (col. 5, lines 30-41).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW PERREAU LT whose telephone number is (571)270-5427. The examiner can normally be reached on Monday - Friday, 8:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P./
Examiner, Art Unit 3728

/J. Gregory Pickett/
Primary Examiner, Art Unit 3728